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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,805	07/28/2003	Makoto Nagao	Q76090	4338

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EXAMINER	
BERNATZ, KEVIN M	
ART UNIT	**PAPER NUMBER**
1773	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/627,805	NAGAO ET AL.	
	Examiner	Art Unit	
	Kevin M Bernatz	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendments to claim 19, filed on January 19, 2005, have been entered in the above-identified application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Examiner's Comments

3. The Examiner notes that the language of claims 10 and 27 have been taken to mean a 70 wt% Fe, 30 wt% Co alloy and a 75 wt% Fe, 20 wt% Ni and 5 wt% Mo alloy.

4. The Examiner notes that claim 15 appears to have a typographical error and should depend from claim 13, not claim 11 (since claim 11 does not recite a lubricant layer).

Claim Rejections - 35 USC § 102

5. Claims 1, 2, 8, 19 – 21, 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sawazaki (U.S. Patent No. 4,422,106) as evidenced by Oda et al. (U.S. Patent No. 5,435,903) for the reasons of record as set forth in Paragraph No.'s 5 – 16 of the Office Action mailed on October 19, 2004.

The Examiner notes that the amended limitations of claim 19 are still process limitations and are addressed per the rejection of record.

6. Claims 1 – 9, 18 – 26 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (WO98/03972) as evidenced by Oda et al. ('903) for the reasons of record as set forth in Paragraph No.'s 17 – 36 of the Office Action mailed on October 19, 2004.

The Examiner notes that the amended limitations of claim 19 are still process limitations and are addressed per the rejection of record.

Claim Rejections - 35 USC § 103

7. Claims 1 – 9, 18 – 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. (WO '972) in view of Oda et al. ('903) and Sawazaki ('106) for the reasons of record as set forth in Paragraph No.'s 38 - 41 of the Office Action mailed on October 19, 2004.

The Examiner notes that the amended limitations of claim 19 are still process limitations and are addressed per the rejection of record.

8. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. as applied above, and further in view of Takahashi et al. (U.S. Patent No. 5,173,370) for the reasons of record as set forth in Paragraph No.'s 42 - 47 of the Office Action mailed on October 19, 2004.

9. Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. in view of Oda et al. and Sawazaki as applied above, and further in view of Takahashi et al. ('370) for the reasons of record as set forth in Paragraph No.'s 48 - 49 of the Office Action mailed on October 19, 2004.

The Examiner notes that the previous Examiner accidentally left out the Oda et al. reference in the basis for the rejection, but clearly referred to the above rejection in the Paragraph 49.

10. Claims 16, 17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. as applied above, and further in view of Nishimatsu et al. (U.S. Patent No. 4,701,375) for the reasons of record as set forth in Paragraph No.'s 50 - 53 of the Office Action mailed on October 19, 2004.

11. Claims 16, 17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. in view of Oda et al. and Sawazaki as applied above, and further in view of Nishimatsu et al. ('375) for the reasons of record as set forth in Paragraph No.'s 54 - 55 of the Office Action mailed on October 19, 2004.

The Examiner notes that the previous Examiner accidentally left out the Oda et al. reference in the basis for the rejection, but clearly referred to the above rejection in the Paragraph 55.

12. Claims 11 – 15 and 28 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. as applied above, and further in view of Kitaori et al. (U.S. Patent No. 5,796,533) and Dearnaley et al. (U.S. Patent No. 5,922,415) for the reasons of record as set forth in Paragraph No.'s 56 - 67 of the Office Action mailed on October 19, 2004.

13. Claims 11 – 15 and 28 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. in view of Oda et al. and Sawazaki as applied above, and further in view of Kitaori et al. ('533) and Dearnaley et al. ('415) for the reasons of record as set forth in Paragraph No.'s 68 - 69 of the Office Action mailed on October 19, 2004.

The Examiner notes that the previous Examiner accidentally left out the Oda et al. reference in the basis for the rejection, but clearly referred to the above rejection in the Paragraph 69.

Response to Arguments

14. The rejection of claims 1, 2, 8, 19 – 21, 23 and 26 under 35 U.S.C § 102(b) – Sawazaki, as evidenced by Oda et al.

15. The rejection of claims 1 - 32 under 35 U.S.C § 102(b) and/or 103(a) – Ishida et al., alone or in view of various references

Applicant(s) argue(s) that a relative permeability "within the range of 10-1,000 as claimed", that "one of ordinary skill in reading the present specification would

understand that relative magnetic permeability, in the context of the present invention, is measured by applying a DC magnetic field", and that "claim 1 directed to a transfer method clearly recites the step of applying a DC magnetic field" (*page 12 of response*). The examiner respectfully disagrees.

First, the examiner notes that the specification is not the measure of the invention. Therefore, limitations contained therein can not be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968). The present claims do not recite how the magnetic permeability is measured and are hence open to both DC and AC, regardless of what one of ordinary skill in the art would allegedly understand. Second, the Examiner notes that there is no evidence in the as-filed disclosure to support applicants allegation that one of ordinary skill in the art would "understand that the relative magnetic permeability, in the context of the present invention, is measured by applying a DC magnetic field". Applicants have not disclosed how they have measured the relative magnetic permeability, and hence, one would postulate that any measurement technique could be utilized.

Finally, the Examiner notes that the claimed recitation of a DC magnetic field is for a completely unrelated purpose to measuring the relative magnetic permeability (i.e. for during information transfer), and hence the argument is moot. Furthermore, applicants' specification clearly teaches that during information transfer, application of both AC or DC magnetic fields are known in the art (*Paragraph 0010*).

In addition, applicants argue that "the measurement of relative magnetic permeability of the magnetic layer of a master carrier ordinarily is not questioned as

being carried out by applying a DC magnetic field" and that "[f]requency rarely, if ever, comes into question", hence clearly indicating that applicants are referring to measurement in a DC magnetic field (*page 13 of response*). The Examiner respectfully disagrees.

The Examiner acknowledges that relative magnetic permeability *can* be measured in a DC magnetic field, as shown by the recited references. However, what is used in the other references is not relevant to what *applicants have disclosed*. Furthermore, applicants own arguments indicate that frequency "rarely, if ever, comes into question", clearly indicating that measurement in an AC magnetic field *is* possible and, while rare, still known in the art. Since applicants have neither claimed measurement in a DC magnetic field, nor disclosed such measurement technique in their as-filed disclosure, the Examiner finds no support to limit the claim language to such an interpretation.

Furthermore, applicant(s) are reminded that ***a detailed description of the reasons and evidence*** supporting a position of unexpected results must be provided ***by applicant(s)***. A mere pointing to data requiring the examiner to ferret out evidence of unexpected results ***is not sufficient*** to prove that the results would be truly unexpected to one of ordinary skill in the art. *In re D'Ancicco,* 439 F.2d 1244, 1248, 169 USPQ 303, 306 (1971) and *In re Merck & Co*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986).

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMB
March 29, 2005

Kevin M. Bernatz, PhD
Primary Examiner